94-706

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1994

WHITE SWAN, LTD.,
Petitioner,

v.

THE NATURE COMPANY,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

PETITIONER'S REPLY BRIEF

J. Pierre Kolisch
Counsel of Record
David P. Cooper
Charles H. DeVoe
KOLISCH HARTWELL DICKINSON
McCORMACK & HEUSER
200 Pacific Building
520 S.W. Yamhill Street
Portland, OR 97204
(503) 224-6655
Attorneys for Petitioner
White Swan, Ltd.

December 7, 1994

RECEIVED
DEC 8 1994
OFFICE OF THE CLERK
SUPREME COURT, U.S.

8 pp

TABLE OF CONTENTS

TABLE OF AUTHORITIES ii

CONCLUSION 5

TABLE OF AUTHORITIES

Cases — Page(s)

Armstrong Cork Co. v. World Carpets, Inc., 597 F.2d 496 (5th Cir. 1979) 4

M. B. H. Enterprises, Inc. v. WOKY, Inc., 633 F.2d 50 (7th Cir. 1980) 4

Venetianaire Corp. of America v. A & P Import Co., 429 F.2d 1079 (2nd Cir. 1970) 4

Rules and Statutes

15 U.S.C. § 1115(b)(4) 3, 4

Lanham Act 3, 4

94-706

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1994

WHITE SWAN, LTD.,
Petitioner,

v.

THE NATURE COMPANY,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

PETITIONER'S REPLY BRIEF

Contrary to respondent's assertion (Br in Opp 2-3) the Petition is not "founded" on whether the mark HUMMINGBIRD GARDEN is or is not incontestable. As will be later pointed out, that is legally irrelevant in the present case. What is relevant is that neither of the two questions set forth in the Petition have been dealt with in Respondent's Brief in Opposition other than by bold negative

assertions without citation of supporting authority.

Question 1 in the Petition involved a conflict among the circuits with respect to the correct standard of review of a district court's decision on a motion for summary judgment. Specifically, that issue was whether the Ninth Circuit had erred in the present case by reviewing under the clearly erroneous standard the district court's finding of the absence of a genuine issue of material fact, descriptiveness. Respondent's Brief in Opposition does not deny the conflict in the various circuits set forth in the Petition. Respondent recognizes the error by the Ninth Circuit in the present case, but seeks to pass it off as a "minor aberration" not worthy of this Court's review because it appeared in an unpublished memorandum decision and the Ninth Circuit court is capable of monitoring and correcting such an aberration (Br in Opp 5). Apparently the Ninth Circuit is not doing that as shown by respondent's citation to an earlier Ninth Circuit unpublished decision that discussed this "aberration."

Question 2 in the Petition is whether summary judgment was proper under the fair use defense where genuine issues of

material fact have been raised.[1] The Brief in Opposition again fails to deal with the conflict in the various circuits' interpretations of the fair use defense. Respondent simply states that there is no conflict and argues that because the registration for HUMMINGBIRD GARDEN is not incontestable as set forth in the Petition, "the Petition should be denied on that basis alone" (Br in Opp 9).

Whether HUMMINGBIRD GARDEN is a contestable or incontestable registration is of no legal significance in this case. The record below only established that HUMMINGBIRD GARDEN is registered under the Lanham Act. The word "incontestable" was inadvertently used in the Petition. However, the controlling section of the Lanham Act is 33(b)(4), 15 U.S.C. § 1115(b)(4), which is the statute construed by the Court of Appeals in this case and which was the statute set forth in Question 2 of the Petition.

Federal courts have applied the fair use defense by referring to § 33(b)(4) of the Lanham Act regardless of whether the mark is a common law mark, registered,

---

[1]Contrary to respondent's erroneous statements, (Br in Opp 5,10) there are genuine issues of material fact in dispute as set forth in Question 2 of the Petition and petitioner's briefs in the court of appeals.

contestable or incontestable. In *Venetianaire Corp. of America v. A & P Import Co.*, 429 F.2d 1079, 1081 (2nd Cir. 1970), the court said:

> The 'fair use' defense explicitly described in [15 U.S.C. § 1115(b)(4)] approximates a statutory restatement of the corresponding common law defense (available to [respondent] here by virtue of the provisions of [15 U.S.C.] § 1115(a)), and federal courts frequently refer to the language of that section when the defense of fair use is raised in actions for infringement pursuant to the Lanham Act.

See also *M. B. H. Enterprises, Inc. v. WOKY, Inc.*, 633 F.2d 50, 52, n.2 (7th Cir. 1980) and *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496, 500, n.3 (5th Cir. 1979).

The pertinency and necessity for resolution of Question 2 presented in the Petition remains whether the mark is contestable or incontestable. The substantial nature of the question for review by this Court remains undisputed. The most that can be said is that use of the word "incontestable" was harmless error in the Petition. It can be disregarded in the Petition without affecting the issues presented for review by the Court.

CONCLUSION

The decision below fully warrants this Court's review. A writ of certiorari should be issued to the Ninth Circuit Court of Appeals.

Respectfully submitted,

J. Pierre Kolisch
Counsel of Record
David P. Cooper
Charles H. DeVoe
KOLISCH HARTWELL DICKINSON
McCORMACK & HEUSER
200 Pacific Building
520 S.W. Yamhill Street
Portland, Oregon 97204
(503) 224-6655

Attorneys for Petitioner
White Swan, Ltd.

December 7, 1994